



26 SEP 2002

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In re Application of
ROIFMAN, et al.
Application No.: 09/936,887
PCT No.: PCT/CA00/00266
Int. Filing Date: 13 March 2000
Priority Date: 12 March 1999
Attorney Docket No.: 280502000200
For: METHODS AND COMPOSITIONS FOR
TREATING LEUKEMIA

DECISION ON PETITION

UNDER 37 CFR 1.181

This is a decision on applicant's "Petition Under 37 C.F.R. § 1.181(a) to Withdraw Holding of Abandonment" filed in the United States Patent and Trademark Office (USPTO) on 05 August 2002.

BACKGROUND

On 13 March 2000, applicant filed international application PCT/CA00/00266, which claimed priority of an earlier application filed 12 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 11 October 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 September 2001.

On 11 September 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a First Preliminary Amendment. An executed oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 01 November 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 informing applicant of the need to provide a signed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant had pre-paid the \$130.00 surcharge for providing an oath or declaration later than 30 months from the priority date. Applicant was afforded two months to provide the missing paper and advised that

this period could be extended with a proper petition and payment of the appropriate extension of time fee.

On 10 May 2002, applicant responded by filing an executed Declaration of the inventors accompanied by a petition for a four-month extension of time and payment of the small entity extension fee. Applicant certified that the response was deposited for mailing on 30 April 2002 and thus timely filed.

On 03 June 2002, applicant was mailed a NOTICE OF ABANDONMENT UNDER 37 CFR 1.53 (f) OR (g) informing applicant that applicant had failed to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 01 November 2001 within the time period set therein and that above-identified application was abandoned as to the United States.

On 05 August 2002, applicant responded with the present request accompanied by copies of an executed declaration of the inventors and other papers referenced above as deposited for mailing 30 April 2002.

DISCUSSION

A review of the application papers reveals that the original response has been located and added to the application papers. Thus, it is appropriate to withdraw the holding of abandonment at this time. Applicant is advised that a review of the filed declaration finds that it is not in compliance with 37 CFR 1.497(a) - (b). The filed declaration contains two "pages 3." This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signatures pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.) In order to fulfill the filing requirements under 35 U.S.C. 371 for entry into the national stage in the United States a complaint oath or declaration of the inventors is required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **DISMISSED as moot.**

The NOTIFICATION OF ABANDONMENT mailed on 03 June 2002 is hereby **VACATED.**

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) as discussed above. No

additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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